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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/754,394	01/09/2004	Michael Frank Walsh	WMFR-P01-001	9186
28120	7590	09/09/2004	EXAMINER	
ROPES & GRAY LLP ONE INTERNATIONAL PLACE BOSTON, MA 02110-2624			GARCIA, ERNESTO	
			ART UNIT	PAPER NUMBER

3679

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/754,394

Applicant(s)

WALSH, MICHAEL FRANK

Examiner

Ernesto Garcia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,2 and 4-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This application contains claims directed to the following patentably distinct species of the claimed invention:

- |                    |             |               |
|--------------------|-------------|---------------|
| I. Figs. 1-3 and 6 | IV. Fig. 8. | VII. Fig. 11. |
| II. Fig. 4         | V. Fig. 9   |               |
| III. Fig. 5        | VI. Fig. 10 |               |

Figures 7 and 12 are subspecies of the mechanism.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 5, 7, 8 and 9 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include

all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Mr. David P. Halstead on 8/23/04 a provisional election was made with traverse to prosecute the invention of specie I, claims 1, 2 and 4-9. Applicant in replying to this Office action must make affirmation of this election. Claim 3 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the

list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the examiner on form PTO-892 has cited the references, they have not been considered.

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "2" has been used to designate both spring pin without an extension as shown in Figure 5 and a spring pin with an extension (Fig. 5). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities:

on pages 3 and 6, applicant uses the term "hangar" in lines 14 of page 3 and in lines 1, 21 and 22, while page 5 uses "hanger" in line 2. Applicant needs to be consistent in using terms.

The disclosure is objected to because of the following informalities:

the name of some of the components in the detail description of the embodiment do not match with those recited in the claims thereby it making difficult to match those components recited in the claim with those of the components referenced. For instance, the specification refers to 1 as a main housing and the claim, as best matched, refers to the same component, as a main structure. Appropriate correction is required.

### ***Claim Objections***

Claims 1, 5, 6, 7 and 9 are objected to because of the following informalities:

regarding claim 1, the first occurrence of "the" in line 5 should be --an--, the third occurrence of "the" in line 5 should be --a--, "release" in line 6 should be --spring--, the second occurrence of "the" in line 7 should be --a--, and the first occurrence of "the" in line 8 should be --a--;

regarding claim 5, the use of the term "hangar" in line 1 conflicts with "hanger" in the specification;

regarding claim 6, "releae" in line 2 should be --release--;

regarding claim 7, the examiner wonders whether “employs” should be --comprising--; and,

regarding claim 9, the first occurrence of “the” in line 5 should be --an--, “release” in line 6 should be --spring--, and the third occurrence of “a” in line 7 should be --the--.  
Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4-7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Eakin, 3,009,729 (see marked-up attachments).

Regarding claim 1, Eakin discloses, in Figures 1-4, a low-force release mechanism comprising a main structure **9**, a trap **19**, an internal spring activation element **33**, at least one trigger **37**, attachments **A5** and a container **7**. The spring activation element **33** interacts with an internal geometry **24** of the trap **19**. The container **7** is attached to the main structure **9** and the trap **19**. Applicant is reminded that the examiner has considered the mechanism in combination with the container as

the limitation "by which" is two-fold and the examiner concluded that applicant is claiming the container as evident by claim 8 further limiting the container.

Applicant is reminded that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Therefore, the manner in which the spring activation element and the internal geometry of the trap are used do not differentiate the element and the geometry of the trap.

Regarding claim 2, the mechanism further comprises at least one ball bearing **32**.

Regarding claim 4, the mechanism further comprises low frictional ball bearings **32**.

Regarding claim 5, the mechanism further comprising a hangar **10**.

Regarding claim 6, the mechanism further comprising a hangar **11**.

Regarding claim 7, the spring activation element **33** employs a spring device.



Regarding claim 9, Eakin discloses, in Figures 1-4, a low-force release mechanism comprising a main structure **9**, a trap **19**, an internal spring activation element **33**, at least one trigger **37**, attachments **A5** and a container **7**. The spring activation element **33** interacts with an internal geometry **24** of the trap **19**. The container **7** is attached to the main structure **9** and the trap **19**. Applicant is reminded that the examiner has considered the mechanism in combination with the container as the limitation "by which" is two-fold and the examiner concluded that applicant is claiming the container as evident by claim 8 further limiting the container.

Applicant is reminded that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Therefore, the manner in which the spring activation element and the internal geometry of the trap are used do not differentiate the element and the geometry of the trap.

Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Niskin, 3,729,855

Regarding claim 1, Niskin discloses, in Figures 1-4, a low-force release mechanism comprising a main structure **10**, a trap **58**, an internal spring activation element **52**, at least one trigger **66**, attachments **56** and a container **20**. The spring

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activation element **52** interacts with an internal geometry **65** of the trap **58**. The container **20** is attached to the main structure **10** and the trap **58**. Applicant is reminded that the examiner has considered the mechanism in combination with the container as the limitation "by which" is two-fold and the examiner concluded that applicant is claiming the container as evident by claim 8 further limiting the container.

Applicant is reminded that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Therefore, the manner in which the spring activation element and the internal geometry of the trap are used do not differentiate the element and the geometry of the trap.

Regarding claim 8, the container 20 is chosen from a group consisting of bags, boxes, collapsible boxes and nets.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 9:30-6:00. The fax phone numbers

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for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E.G.

August 31, 2004

Attachments: one marked-up copy of Eakin, 3,009,729.



DANIEL P. STODOLA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

FIG.3.

